

REMARKS

Applicants appreciate the indication that the application is allowable. The formal matters identified in the *Quayle* Office Action are addressed below in the same order as presented in the action.

1.A. The Office Action objected to the declaration because it does not identify a residence address for inventor Ron Cohen. The Office Action stated that a new declaration is required, but also stated that the residence information could be provided on an Application Data Sheet. Applicants have interpreted the Office Action to mean that submitting an ADS alone is sufficient, as Mr. Cohen is no longer employed by the assignee, and obtaining a signed substitute declaration is inconvenient. Therefore, an ADS providing the requested residence data is submitted herewith.

1.B. The Office Action objected to the specification as having an incomplete sentence at page 17, lines 7-10. The associated paragraph is amended herein.

1.C. The Office Action objected to informalities in the claims and requested correction. Claims 21-29 (as renumbered) are amended herein as requested in the Office Action.

Applicants have not amended claims 1-20. In each of these claims, the Office Action requests spelling out the acronym "DSCP," and adding the word "and" after "flow." However, no rationale for the objections is given. The Office may reject claims that fail to comply with §112, second paragraph, by failing to particularly point out and distinctly claim the invention. Applicants respectfully submit that the objections and requested amendments are so trivial that the objections cannot properly be made under §112, second paragraph. The requested amendments will not contribute to increased clarity of the claims. For example, the term "DSCP" is defined in the specification, and Docket No.: 50325-0503

has one and only one meaning in the pertinent technical field. The use of the term "and" before the last step of a claim is a subjective preference of style. The Office Action gives no specific rationale for the requested amendments. The claims are believed to fully comply with §112, second paragraph.

Moreover, an amendment to a claim made for any reason relating to patentability, including overcoming rejections under 35 U.S.C. §112, entitles the claim to **no scope of equivalents** under the Doctrine of Equivalents before a court in any future litigation. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865, 1868, 1870 (Fed. Cir. 2000) (*en banc*). Most applicants and their counsel are extremely reluctant to amend any claim in any manner that is not strictly necessary. Here, the requested amendments are not necessary.

The Office Action does not specifically cite §112, and recites an objection rather than a rejection based upon a particular section of the statute. Further, all amendments made herein by Applicants have been strictly to address formalities and not for any reason relating to patentability. However, Applicants are concerned that if all the requested amendments were made, a future court could interpret the amendments as made under §112, or for some other reason relating to compliance with the patent statutes, or otherwise "substantially related to patentability." Further, a court could interpret the requested amendments as limiting, because introduction of the term "and" tends to indicate that the claims are closed-ended, which they are not, by use of the preamble transition term "comprising."

As there is no rationale articulated for the objections in the Office Action, and no clear benefit to the public for the requested amendments, and no basis for rejection under the statute. Because the harsh result of *Festo* is not outweighed by any benefit of the

Docket No.: 50325-0503

requested amendments, Applicant respectfully requests reconsideration and withdrawal of the objections to claims 1-20.

#### CONCLUSION

For the reasons set forth above, all pending claims are patentable over the art of record. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

No extension fee is believed to be due. However, to the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in relation to this application to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: May 17, 2004



Christopher J. Palermo  
Reg. No. 42,056

1600 Willow Street  
San Jose, California 95125-5106  
Telephone No.: (408) 414-1202  
Facsimile No.: (408) 414-1076

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on May 17, 2004 by [Signature]